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EXAMINER

BAYARD, DJENANE M

ART UNIT	PAPER NUMBER
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2141

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/717,303	Applicant(s) WANG BALDONADO ET AL.	
	Examiner DJENANE M. BAYARD	Art Unit 2141	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 July 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,5,6,8,9,11,13,14,16,17,19,21,22,24,25,31-33 and 39-47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3, 5-6, 8-9, 11, 13-14, 16-17, 19, 21-22, 24-25, 31-33, 39-47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This is in response to communication filed on 7/09/08 in which claims 1, 3, 5-6, 8-9, 11, 13-14, 16-17, 19, 21-22, 24-25, 31-33, 39-47 are pending.

Response to Arguments

Applicant's arguments have been fully considered but they are not persuasive. Applicant argues that Knight fails to teach a need to spawn a new electronic forum because the purpose of Knight is to find desired information in a forum-independent manner based on the content of the available information. However, Knight et al teaches a message traffic monitor routine 538. This routine is generally configured to analyze user queries, commands, postings and interface settings (i.e., which groups/authors are listed as favorites of a user) to tabulate the information discussed above in connection with 3D, such as hot discussion areas, including the "Top 10" posters list noted above for example. In other words this routine monitors such information as what groups, classifications, sub-classifications, topics, authors, chat rooms, interface customizations, etc., are being accessed the most (or least); what users are posting the most entries, etc., and creates one or more tabulation databases (See col. 24, lines 52-65). The prior art of Burnstein et al was introduced to emphasize the teaching of Knight et al. Burnstein et al teaches clearly wherein an invention that contacts the currently searching and the previously searching users and asks them if they want to join a new community on the topic of the search string in the following manner. Initially the current searching user is contacted by the invention automatically. If that person indicates their interest in joining a community then the second action of the invention is to locate non-searching user(s) in the matched field and contacted them

Art Unit: 2141

and ask if they want to join this community. If each answers in the affirmative, the invention automatically forms a new community and the users are entered as members of that community (See page 8, paragraph [0098]). Furthermore, Burnstein et al teaches a subscriber determining device that determines which of the queried users indicate interest in the new electronic forum and subscribes each interested user to the new electronic forum, but does not subscribe users of the set who do not indicate interest in the new electronic forum (See page 8, paragraph [0098 and 0100-0101]). Furthermore, Burnstein et al teaches wherein the input can be E-mail (See page 8, paragraph [01001]).

Furthermore, Applicant argues that Burnstein et al fails to teach "not subscribing to the new electronic forum users of the set who do not indicate interest". Burnstein teaches wherein "a community is defined as a list of two or more users that wish to communicate with each other based upon matching words of search strings" (See page 11, paragraph [0137]).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, it would have been obvious to one with ordinary skill in the art at the time the invention was made to incorporate forum spawning device that queries a set of users when at least one of the at least one rules is satisfied and creates a new forum based on one or more replies from the set of users as taught by Burnstein et al in the claimed invention of Knight et al

Art Unit: 2141

in order to invite the match parties to join a frictionless and immediate electronic community if they so desire (See page 1, paragraph [0013]).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 3, 5-6, 8-9, 11, 13-14, 16-17, 19, 21-22, 24-25, 31-33 and 39-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,778,982 to Knight et al in view of U.S. Patent Application No. 2002/0032735 to Burnstein et al.

a. As per claims 1, 9 and 17, Knight et al teaches an online content provider system and method for compiling, creating and presenting content to users. Furthermore, Knight et al teaches an information monitoring device adapted to monitor one or more electronic documents in an information stream associated with a first electronic forum, and compares information about the one or more electronic email documents to two or more rules (See col. 9, lines 43-50

Art Unit: 2141

and col. 22, lines 35-44), *Remark: Knight teaches first kind of extraction robot of the present invention periodically retrieve content from outside sources and online message board system. The content is extracted from these sources according to set of rules, filters or criteria specified by the online provider, and/ or gleaned from community based traffic monitoring*);

Furthermore, Knight et al teaches a forum wherein the two or more rules comprise at least two of the following: how long the electronic forum has been in use; how many email messages have been exchanged on the electronic forum; whether there has been a suggestion to create a new discussion forum; whether a certain number of email messages on a particular topic been received within a predetermined time period; whether the rate of email messages exchanged on a particular topic been statistically greater than normal; or whether a certain number of forum members exchanged email messages on a particular topic within a predetermined time period (See col. 20, lines 22-32 and col. 24, lines 52-65). However, Knight et al fails to teach forum spawning device adapted to query a set of users when at least two of the at least two or more rules is satisfied and creates a new forum based on one or more replies from the set of users and a subscriber determining device adapted to determine which of the queried users indicate interest in the new electronic forum and subscribes each interested user to the new electronic forum, but does not subscribe users of the set who do not indicate interest in the new electronic forum.

Burnstein et al teaches an automatic telephone, internet or intranet community formation. Furthermore, Burnstein et al teaches wherein an invention that contacts the currently searching and the previously searching users and asks them if they want to join a new community on the topic of the search string in the following manner. Initially the current searching user is

Art Unit: 2141

contacted by the invention automatically. If that person indicates their interest in joining a community then the second action of the invention is to locate non-searching user(s) in the matched field and contacted them and ask if they want to join this community. If each answers in the affirmative, the invention automatically forms a new community and the users are entered as members of that community (See page 8, paragraph [0098]). Furthermore, Burnstein et al teaches a subscriber determining device that determines which of the queried users indicate interest in the new electronic forum and subscribes each interested user to the new electronic forum, but does not subscribe users of the set who do not indicate interest in the new electronic forum (See page 8, paragraph [0098 and 0100-0101]). Furthermore, Burnstein et al teaches wherein the input can be E-mail (See page 8, paragraph [01001]).

It would have been obvious to one with ordinary skill in the art at the time the invention was made to incorporate forum spawning device that queries a set of users when at least one of the at least one rules is satisfied and creates a new forum based on one or more replies from the set of users as taught by Burnstein et al in the claimed invention of Knight et al in order to invite the match parties to join a frictionless and immediate electronic community if they so desire (See page 1, paragraph [0013]).

b. As per claims 3, 11, and 19, Knight et al in view of Burnstein et al teaches the claimed invention as described above. However, Knight et al fails to teach wherein the forum spawning device queries the set of users to determine the need for the new forum.

Burnstein et al teaches wherein the forum spawning device queries the set of users to determine the need for the new forum (See page 8, paragraph [0098]).

I would have been obvious to one with ordinary skill in the art at the time the invention was made to incorporate wherein the forum spawning device queries the set of users to determine the need for the new forum as taught by Burnstein et al in the claimed invention of Knight et al in order to invite the match parties to join a frictionless and immediate electronic community if they so desire (See page 1, paragraph [0013]).

c. As per claims 5, 13 and 21, Knight et al in view of Burnstein et al teaches the claimed invention as described above. However, Knight et al fails to teach a subscriber maintenance device that associates the new electronic forum and a set of users indicating interest in the new electronic forum.

Burnstein et al teaches a subscriber maintenance device that associates the new electronic forum and a set of users indicating interest in the new electronic forum (See page 8, paragraph [0098-0101]).

I would have been obvious to one with ordinary skill in the art at the time the invention was made to incorporate wherein the forum spawning device queries the set of users to determine the need for the new forum as taught by Burnstein et al in the claimed invention of Knight et al in order to invite the match parties to join a frictionless and immediate electronic community if they so desire (See page 1, paragraph [0013]).

d. As per claims 6, 14 and 22, Knight et al in view of teaches the claimed invention as described above. Furthermore, Knight et al teaches an electronic document storage device that

stores the one or more electronic documents (See col. 22, lines 35-44). However, Knight fails to teach wherein the message can be e-mail.

Burnstein et al teaches wherein the input can be E-mail (See page 8, paragraph [01001]).

It would have been obvious to one with ordinary skill in the art at the time the invention was made to incorporate forum spawning device that queries a set of users when at least one of the at least one rules is satisfied and creates a new forum based on one or more replies from the set of users as taught by Burnstein et al in the claimed invention of Knight et al in order to invite the match parties to join a frictionless and immediate electronic community if they so desire (See page 1, paragraph [0013]).

e. As per claims 8, 16 and 24, Knight et al teaches wherein an information comparison is based on at least one of a rule-based model and a statistical-based model (col. 9, lines 25-65).

f. As per claim 25, Knight et al teaches the information storage media wherein an information comparison compares at least one of subject information; electronic document posting information; and document tracking information (See col. 9). However, Knight fails to teach wherein the message can be e-mail.

Burnstein et al teaches wherein the input can be E-mail (See page 8, paragraph [01001]).

It would have been obvious to one with ordinary skill in the art at the time the invention was made to incorporate forum spawning device that queries a set of users when at least one of the at least one rules is satisfied and creates a new forum based on one or more replies from the

Art Unit: 2141

set of users as taught by Burnstein et al in the claimed invention of Knight et al in order to invite the match parties to join a frictionless and immediate electronic community if they so desire (See page 1, paragraph [0013]).

g. As per claim 31-33, Knight et al teaches wherein the information stream comprises one or more electronic messages flowing between two or more of the users (See col. 5, lines 3-10). However, Knight fails to teach wherein the message can be e-mail.

Burnstein et al teaches wherein the input can be E-mail (See page 8, paragraph [01001]).

It would have been obvious to one with ordinary skill in the art at the time the invention was made to incorporate forum spawning device that queries a set of users when at least one of the at least one rules is satisfied and creates a new forum based on one or more replies from the set of users as taught by Burnstein et al in the claimed invention of Knight et al in order to invite the match parties to join a frictionless and immediate electronic community if they so desire (See page 1, paragraph [0013]).

h. As per claims 39, 42 and 45, Knight et al in view of Burnstein et al teaches the claimed invention as described above. Furthermore, Knight et al teaches wherein the comparison is between newer email messages and older messages to determine when a new topic of conversation has begun (See col. 24, lines 52-65).

i. As per claims 40, 43 and 46, Knight et al in view of Burnstein et al teaches the claimed invention as described above. Furthermore, Knight et al teaches wherein the information

Art Unit: 2141

monitoring device detects whether the new topic of conversation is likely to generate additional messages (See col. 10, lines 5-10). However, Knight fails to teach wherein the message can be e-mail.

Burnstein et al teaches wherein the input can be E-mail (See page 8, paragraph [01001]).

It would have been obvious to one with ordinary skill in the art at the time the invention was made to incorporate forum spawning device that queries a set of users when at least one of the at least one rules is satisfied and creates a new forum based on one or more replies from the set of users as taught by Burnstein et al in the claimed invention of Knight et al in order to invite the match parties to join a frictionless and immediate electronic community if they so desire (See page 1, paragraph [0013]).

j. As per claims 41, 44 and 47, Knight et al in view of Burnstein et al teaches the claimed invention as described above. Furthermore, Knight et al teaches wherein the subscribers to the new electronic forum receive messages form both the first electronic forum and the new electronic forum (See col. 10). However, Knight fails to teach wherein the message can be e-mail.

Burnstein et al teaches wherein the input can be E-mail (See page 8, paragraph [01001]).

It would have been obvious to one with ordinary skill in the art at the time the invention was made to incorporate forum spawning device that queries a set of users when at least one of the at least one rules is satisfied and creates a new forum based on one or more replies from the set of users as taught by Burnstein et al in the claimed invention of Knight et al in order to invite

the match parties to join a frictionless and immediate electronic community if they so desire (See page 1, paragraph [0013]).

5. Claims 35-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,778,982 to Knight et al in view of U.S. Patent Application No. 2002/0032735 to Burnstein et al as applied to claims 1, 9, 17 and 26 as applied above, and further in view of U.S. Patent Application No. 2002/0059164 to Shtivelman.

a. As per claims 35-38, Knight et al Burnstein et al teaches the claimed invention as described above. However, Knight et al in view of Burnstein et al teaches wherein the one or more rules comprise at least one of the following: how long the current discussion forum has been in use; how many email messages have been exchanged on the forum; whether there has been a suggestion to create a new discussion forum; whether a certain number of email messages on a particular topic been received within a predetermined time period; whether the rate of email messages exchanged on a particular topic been statistically greater than normal; or whether a certain number of forum members exchanged email messages on a particular topic within a predetermined time period.

Shtivelman teaches whether a certain number of forum members exchanged messages on a particular topic within a predetermined time period (See page 5, paragraph [0052]).

It would have been obvious to one with ordinary skill in the art at the time the invention was made to incorporate whether a certain number of forum members exchanged messages on a

Art Unit: 2141

particular topic within a predetermined time period as taught by Shtivelman in order to calculate new message load/responses parameters (See page 5, paragraph [0052]).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DJENANE M. BAYARD whose telephone number is (571)272-3878. The examiner can normally be reached on Monday- Friday 5:30 AM- 3:00 PM..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on (571) 272-3880. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Djenane Bayard

/D. M. B./
Examiner, Art Unit 2141
/William C. Vaughn, Jr./

Application/Control Number: 09/717,303

Page 13

Art Unit: 2141

Supervisory Patent Examiner, Art Unit 2144